

Remarks and Interview Report

In response to the Office Action, assignee respectfully requests consideration of the above amendments and following remarks.

Assignee thanks the Examiner for the telephone interview on February 7, 2007, as recorded in the interview summary of February 26, 2007. In that interview, the Examiner seemed to understand the points discussed below and cordially invited assignee to submit a proposed draft response with amendments and remarks explaining the positions discussed in the meeting. Assignee has done so, and the Examiner (with his supervisor, SPE Vaughn) and the undersigned had a further conversation today, which was quite useful to understand the positions of the Office and the Examiner's thinking. The discussion in today's interview will be addressed in connection with the discussion of specific claims below.

Claims 1-14 and 44-48 have been allowed in the Office Action. Assignee thanks the Office and the Examiner for their work and careful consideration of those claims.

I. ADDITIONAL CLAIMS ALLOWABLE FOR PARALLEL REASONS.

To avoid need for appeal and place additional claims in condition for allowance, assignee has proposed amendments to independent claims 15, 16, 22, and 25 (and dependent claim 50) that parallel certain limitations present in the allowed claims and which will avoid any possible reading of the Yamaguchi reference (used in the final Office Action in combination with a supporting reference) to meet the claimed invention as a whole.

Because the same core distinction applies with respect to those four independent claims as was already present for the allowed claims, it cannot be said that consideration of the amendment of those claims would necessitate a new search or consideration. Also, the amendments would place these claims in better condition for allowance of appeal. Hence, the amendments are suitable for entry under Rule 116.

Parallel reasons for allowance apply to these claims for the following reasons:

With respect to independent claim 15, assignee respectfully requests reconsideration of the rejection for obviousness over Yamaguchi in view of Kuzma. Claim 15 includes a "means for accepting, into a first field of the message, indicia

identifying addresses of one or more recipients of the message and, accepting, into a second and third field, indicia designating each recipient as having viewing or editing privileges of the file, respectively.” That element is presented in “means plus function” format. As stated in MPEP 2106 at p. 2100-7 to -8 (8th ed. Rev. 5 Aug. 2006):

“Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and ‘equivalents thereof’ that correspond to the recited function. Two *en banc* decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (*en banc*); *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (*en banc*).”

Here, therefore, the above-quoted “means” in part (a) of claim 15 refers to means for accepting indicia into three separate fields designating addresses and whether each intended recipient has viewing or editing privileges. Such a “means for accepting” cannot be simply code that allows accepting addresses into ordinary (to, cc, or bcc) fields, as shown in Yamaguchi, which fields are defined to allow certain privileges, as that arrangement is neither disclosed in the present specification nor an equivalent thereof. Kuzma is not asserted to disclose this claim element. As a result, the reasons for allowance stated in the Office Action apply equally well to the invention defined by claim 15, properly construed, and that claim should be allowed.

With respect to independent claim 16, assignee again respectfully requests reconsideration based on parallel reasons for allowance. Claim 16 refers to “a message program” that normally has “a message window including [1] a message recipient field and [2] a file identification field.” The claim further specifies the step of “causing the electronic message program to display a message window that, further to the message recipient field, also includes [3] a file viewer field and [4] a file editor field.” Claim 16, part (a) (emphasis and numerals added). As recognized in the reasons for allowance, “Yamaguchi ... did not disclose a first, second, and third field for generating authorization data used to authorize a requesting user for viewing or modifying a file as claimed.” [OA, p. 7]

The amendment should not be needed to maintain the distinction being argued, because the word “further” was already included in the claim. However, in today’s interview, the Examiner stated, in effect, that clarification of the antecedent to the word “further” would make for a clearer claim that made explicit the desired interpretation. Assignee has no difficulty offering this amendment to confirm its original intent.

Accordingly, claim 16 is allowable too. Assignee notes, finally, that the Office has previously allowed claim 16 (although it was later re-worded for clarity, without changing the general thrust of the claim). [See OA dated 7/27/05]

Claims 17-21 depend on claim 16 and are equally allowable, even without discussing any additional elements. However, assignee notes that dependent claim 21 contains specific reference to the fields being labeled VIEWER and EDITOR, which emphasizes the point made above. Also, assignee notes that dependent claim 20 has been indicated allowable apart from claim 16.

Claim 22 is an independent “*Beauregard*” (stored computer program) claim having parallel limitations to claim 16. The same remarks and reasons discussed above in connection with claim 16 apply to justify allowance of this claim too. In the interview, Mr. Vaughn stated that the Examiner would telephone the undersigned before any further action if any separate issues arose from the Beauregard format.

Claims 23-24 depend on claim 22 and are equally allowable, even without discussing any additional elements.

Claim 25 is another independent claim, and although its limitations differ from claims 16-24, a similar distinction applies over the cited art. Claim 25 refers to a program that has recipient and attachment fields, and specifies that there must be “include[d], in a field of the electronic message separate from the message recipient field, indicia designating addresses entered into the message recipient field as associated with message recipients having viewing or editing privileges of a file entered into the file identification field.” Claim 25, part (c) (emphasis added). Yamaguchi, by contrast, lacks any “indicia” – included in the email – to designate whether any address entered into any “message recipient field” has viewing or editing privileges.

To respond to the request in today's interview for clarification of the term "indicia," assignee directs the Examiner to the embodiments of Figures 4 and 5 of the present specification. In the Figure 4 embodiment, the indicia of viewing and editing privileges are the email addresses themselves, entered in fields 424, 426. See especially para. 0078. In the Figure 5 embodiment, by contrast, the indicia of viewing and editing privileges are entered as "radio button" checks in fields 524, 526. See especially para. 0083.

More generally, "indicia" (consistent with ordinary meaning) refers to marks or indicators, which may be (for example) alphanumeric, checkmarks, or some other code, in this case electronically accepted. The Examiner asked today whether "indicia" could be viewed broadly enough to refer to the mere existence of an address in a certain field (as in Yamaguchi). In the context of claim 25, though, the indicia must be included in a field different from the addressee field. Accordingly, claim 25 is distinct from the prior art for reasons parallel to those justifying allowance of claim 1 and should be allowed.

II. ADDITIONAL CLAIM GROUP ALLOWABLE.

In both of the referenced interviews, assignee's representative notified the Examiner that it appears as if the Final Office Action did not fully appreciate a distinction from the prior art present in a group of other claims – the distinction generally relating to transferring the file associated with the email differently based on the authorization status (such as might be indicated in the viewer and editor fields, if present). Both times, the undersigned asked whether the Office had an argument for how either of the combined references (Yamaguchi or Kuzma) would have caused the ordinarily skilled artisan to have thought to incorporate this feature in the combination. Both times, the Examiner (and today, the SPE) promised to consider the point again but provided no explanation for why either of those references contained the feature. From that response, assignee submits that it appears that allowance is justified. Assignee respectfully requests reconsideration and allowance on that ground.

Claim 29 requires transfer of file data either as an attachment to an email or separately, based on the direct-file-access authorization status, for each address. See Claim 29, part (c). As the Office Action concedes, "Yamaguchi did not specifically

disclose for each electronic message sent to a file accessor address authorized for direct file access, transmitting data of the file separately from the electronic message.” [OA, p. 5, 1st sentence] However, the Office Action purports to find the element missing from Yamaguchi in Kuzma, stating that Kuzma discloses sending attachment files by reference and thus separately from an email message. [OA, para. 11] But Kuzma does not disclose what is required by claim 29, part (c), namely “based on the authorization status, for each address authorized for direct file access, transmitting data of the file separately from the electronic message, and for each address not authorized for direct file access, transferring data of the file as an attachment to the electronic message.” It is not understood how Kuzma discloses transmitting data either separately or as an attachment, depending on DFA authorization status, as claimed. Because claim 29 contains that limitation, it is non-obvious over the art of record, even if the references were properly combined. The claim should be allowed.

Claims 30-33, 37, and 38 depend on claim 29 and are equally allowable, even without discussing any additional elements. However, assignee notes that dependent claims 33, 37, and 38 have been indicated allowable apart from claim 29.

Claim 49 is an independent “*Beauregard*” (stored computer program) claim having parallel limitations to claim 29. The same reasons discussed above apply to justify allowance of this claim too.

Claims 50-52 depend on claim 49 and are equally allowable, even without discussing any additional elements. However, assignee notes that these claims have been indicated allowable apart from claim 49.

III. CLAIMS AMENDED FROM “SIGNAL” FORMAT.

Two independent claims had originally been presented in “propagated signal” form. The PTO has previously allowed claims in that format, but the Office issued certain revised guidelines that led the Group to determine, apparently, that such claims ought not to be allowed any more. To avoid a dispute over that unsettled issue, assignee last amended the claims to claim apparatus comprising a transmission medium and a data stream with certain characteristics.

In the interview today, the Examiner indicated that his concern was that the “transmission medium” could be a non-statutory sort of medium, and he further suggested (at least initially) that the medium could be EM signals or carrier waves traveling between two transmission towers in a wireless situation or be intangible. Assignee respectfully requests reconsideration and careful thought about this rejection.

First of all, clearly a Beauregard claim is statutory, and such a claim consists of a signal (actually, software or “indicia of instructions”) residing on a “data storage medium.” The proposed claims, likewise, refer to signals (actually, a “data stream”) residing on a “transmission medium,” and they likewise should be patentable, provided that the transmission medium is tangible.

Second, assignee respectfully cautions that the Office should not confuse the medium with the message. The Office Action (p. 3) states, “The claimed ‘transmission medium’ can be reasonably be interpreted by one of ordinary skill in the art as intangible transmission mediums” The transmission medium – as opposed to the electromagnetic (or other) signals that pass over the medium – is not “intangible subject matter.” Tangible devices, such as optical fibers or electrical wires, typically form a transmission medium. See generally specification, para. 0047. Even wireless transmission relies on tangible equipment (such as transceivers and the transmission towers referenced in today’s interview, or satellites and links). The medium must form part of a “computer network,” providing further evidence of its tangible nature.

Third, the Office Action (p. 3) relies on a faulty premise, namely, “although the preamble recites an apparatus, since the claimed limitations defining the apparatus are directed to intangible subject matter, the [claim is] non-statutory.” That comment reveals a misunderstanding of the claims in this category. The preamble of claim 26, for example, reads simply, “An apparatus,” and nothing more, and is followed by the word “comprising.” Everything thereafter is part of the body of the claim. The claim thus begins, “An apparatus comprising: (1) a transmission medium forming at least part of a computer network; and (2) a data stream in the transmission medium of the network” The “transmission medium” is therefore part of the claim’s body.

With those points in mind, it can be seen that claim 26, the first claim in this category, is directed to an intangible data stream contained in (or passing through) a tangible transmission medium that is part of a computer network. That combination of elements represents a machine (or manufacture), complies with the revised interim guidelines, and is statutory. If the Office wishes to maintain a rejection, a scholarly discussion of the guidelines and explanation of the Office's reasons – one that avoids misunderstandings of the nature of the claim – would be much appreciated.

Claim 26 further stands rejected as obvious over Yamaguchi in view of Kuzma. However, again, claim 26 specifies that the data stream in the machine contains data representing, separately, [1] “a message recipient frame,” [2] “a file editor frame,” and [3] “a file viewer frame.” See Claim 26, parts (b)-(d). As already acknowledged in the reasons for allowance, Yamaguchi lacks designating message recipients as having viewing or editing privileges in separate parts of the email. Because claim 26 contains that limitation, it is non-obvious over the art of record.

Claim 27 depends on claim 26 and is equally allowable, even without discussing its additional element.

With regard to claim 53, assignee respectfully requests reconsideration of all three grounds of rejections, for the following reasons:

First, claim 53 stands rejected as non-statutory (35 U.S.C. §101) for the same grounds as applied to claim 26. The comments above with respect to claim 26 should overcome this rejection.

In addition, assignee proposes inserting the word “tangible” in the reference to the medium in claim 53, which should further remove any doubt as to the tangible nature of the transmission medium. This amendment would place the claim in better condition for allowance or appeal, and it is ripe for entry under Rule 116.

Second, claim 53 stands rejected as obvious over Yamaguchi in view of Kuzma. However, again, claim 53 specifies that the data stream in the machine contains data representing, separately, [1] “header data” identifying the “destination computer,” which is similar to the addressee/recipient of the message (part (a)), [2] “third frame” data identifying whether a destination computer will permit access for “display” of the

attachment (part (d)), and [3] “fourth frame” data identifying whether a destination computer will permit access for “modification” of the attachment (part (e)). As already acknowledged in the reasons for allowance, Yamaguchi lacks designating message recipients as having viewing or editing privileges in separate parts of the email. Because claim 53 contains those limitations, it is non-obvious over the art of record.

Third, claim 53 stands rejected as indefinite for use of the term “properly programmed.” Assignee proposes an amendment to cancel that term, in the several places where used. This element is unnecessary, and its removal will not require further examination of the claim or alter the reasons why the claim is allowable. Accordingly, to place the claim in better condition for allowance or appeal, entry of this amendment is permitted under Rule 116, and assignee respectfully request that the Office allow the curative amendment to overcome this rejection and gain allowance or at least to focus the issues on appeal better.

Claim 54 depends on claim 53 and is equally allowable, even without discussing its additional element.

Assignee and the undersigned thank the Office for its consideration and respectfully request prompt allowance. If any further questions or issues arise, the undersigned invites the Examiner to call.

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